PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yuki SASAKI et al. Group Art Unit: 1618

Application No.: 10/731,031 Examiner: J. ROGERS

Filed: December 10, 2003 Docket No.: 118048

For: RESIN POWDER FOR COSMETIC AND COSMETIC USING THE SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the September 12, 2007 Final Rejection in this application. A Notice of Appeal and fee in the amount of $510 is filed concurrently herewith. The Commissioner is also authorized to charge any additional fee or credit any overpayment associated with this communication to Deposit Account No. 15-0461.

Claims 1-16 and 18-20 are pending in this application. Claims 1-16 and 18-20 stand finally rejected. No amendments are being filed with this request.

The following grounds of rejection are presented for review: (1) claims 1-15 and 18-20 under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Publication No. 2003/0044370 to Sasaki et al. (Sasaki et al. '370), (2) claims 1-15 and 18 under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,893,649 to Sasaki et al. (Sasaki et al. '649), and (3) claims 1-16 and 18-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sasaki et al. '370 in view U.S. Publication 2003/0023021 to Sakuma.

Applicants respectfully submit that the factual basis of the prior art rejections contain clear factual errors.

I. Rejections under 35 U.S.C. §102(e)

Claims 1, 15 and 18-20 require a resin powder for cosmetic including particles containing a resin, wherein the particles have undergone a reshaping treatment, the particles satisfying the equations: $0.5 < b/a$

< 1 and $0.4 < c/b < 0.8$, where a is a major axis of each particle, b is a minor axis of each particle, and c is a thickness of each particle.

The Patent Office alleges that Sasaki '370 and Sasaki '649 disclose particles with an SF1 of between 110 and 140 as in the present application, and thus would allegedly inherently have the recited dimensions (see last paragraph of page 4 of outstanding Office Action). This is factually in error for several reasons, including that (1) neither Sasaki et al. '370 nor Sasaki et al. '649 teach or suggest performing a reshaping treatment and (2) the evidence of record confirms that a, b and c are independent of SF1 values, i.e., a given SF1 value does not inherently result in the b/a and c/b ratios being met, as required in claims 1, 15 and 18-20.

A. <u>The Allegation that a, b and c Is Dependent Upon SF1 Is Factually in Error</u>

A particle's b/a and c/b ratios are not dependent on SF1 values as alleged by the Patent Office. For example, Preparation Examples 1, 3 and 4 of the present application illustrate that SF1 values are independent of the dimensions b/a and c/b. SF1 values are obtained by the ratio of a circle area based on a maximum length of particles to a projected area of the particles, whereas a, b and c are representative of a major axis, a minor axis, and a thickness, respectively, of each particle. Thus, the dimensions b/a and c/b can <u>not</u> be specified or predicted by a given SF1 value and the dimensions b/a and c/b can <u>not</u> be predicted to be achieved without reshaping the particles. In fact, the first and second Declarations confirm that the particles of the Sasaki references that have SF1 values within the recited range, have b/a values and c/b values outside the requirements recited in claims 1, 15 and 18-20 because the particles were not reshaped.

B. <u>The Patent Office's Dismissal of Evidence in the First Declaration under 37 CFR §1.132 as Allegedly Irrelevant to an Anticipation Rejection Is Factually in Error</u>

The first Declaration under 37 CFR §1.132, filed on December 15, 2006, clearly established that required dimensions of the particles in claims 1, 15 and 18-20 are <u>not</u> inherent to particles formed in accordance with the teachings of Sasaki references. The Patent Office erred by dismissing this evidence as allegedly irrelevant to an anticipation rejection, and as allegedly not being representative of the Sasaki references. For the particles of the Sasaki references to inherently have the required dimensions as erroneously alleged by the Patent Office, all particles in accordance with the Sasaki references must have

the required dimensions as recited in claims 1, 15 and 18-20. However, the first Declaration provides evidence, as set forth in Table 1 of the first Declaration, that particles of resin powders formed in accordance with the teachings of Sasaki et al. '370 and Sasaki et al. '649 exhibit b/a = 1 and c/b = 1, which clearly fail to satisfy the recited equations, $0.5 < b/a < 1$ and $0.4 < c/b < 0.8$, as specifically defined in claims 1, 15 and 18-20. Maintaining the rejection in the face of evidence that the particles of the Sasaki references do not inherently achieve the required b/a and c/b ratios based on the SF1 values is error. The Patent Office also erroneously asserts that the evidence presented in the first Declaration is insufficient in only showing one working example of Sasaki '370 with particles having a SF1 of 112 and one working example of Sasaki '649 with particles having a SF1 of 115. Applicants submit that this evidence is sufficient. Without reshaping, which is not taught to be done in the Sasaki references, different b/a and c/b values would not be expected in the Sasaki references. The evidence is thus representative of the teachings in the Sasaki references, and shows that the Sasaki references do not inherently describe particles having the required b/a and c/b ratios.

C. The Patent Office's Dismissal of Evidence in Second Declaration as Allegedly Being a Narrow Interpretation of the Sasaki References Taken from Only one Example of Each Reference Is Also Factually in Error

The second Declaration under 37 CFR §1.132, filed on July 5, 2007 clearly established, as set forth in Table 1 of the second Declaration, that particles of resin powders according to the teachings of (1) Sasaki et al. '370 exhibit b/a values of 1 (see first comparative examples 1 and 3-7 in Table 1) and c/b = 1 (see comparative examples 1-7 in Table 1) and (2) Sasaki et al. '649 exhibit b/a values of 0.8 (see second comparative examples 6 and 8 in Table 2), 0.9 (see second comparative example 5 in Table 2) or 1 (see second comparative examples 1-4 and 7 in Table 2) and c/b = 0.9 (see second comparative examples 3, 6 and 7 in Table 2), 1 (see second comparative examples 1, 2, 4 and 8 in Table 2) or 1.1 (see second comparative example 5), which clearly fail to satisfy the ratios of the present claims. Tables 1 and 2 of the second Declaration also confirm that even though comparative examples 1-7 in Table 1 and second comparative examples 1-4 and 7 in Table 2 may have a shape factor SF1 value within a range of 110 to 140, the particles of comparative examples 1-7 and of second comparative examples 1-4 and 7 still fail to satisfy

the equations of claims 1, 15 and 18-20. As discussed above and evidenced in the Second Declaration, all particles in accordance with the Sasaki references do not have the required dimensions, which indicates that the required dimensions are not inherent to the particles of the Sasaki references as alleged by the Patent Office. Thus, the evidence in the Second Declaration further illustrates that the particles of the Sasaki references fail to satisfy the required equations in claims 1, 15 and 18-20, again at least because the particles are not reshaped to have dimensions that satisfy those required equations.

In view of the evidence illustrated in the first and second Declarations, claims 1, 15 and 18-20 are not anticipated by the Sasaki references. Moreover, the basis of the Examiner's allegations and dismissal of the evidence in the First and Second Declarations is factually incorrect.

In view of the foregoing, the Sasaki references fail to disclose each and every limitation of independent claims 1-16 and 18-20. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

II. Rejection under 35 U.S.C. §103(a)

Applicants submit that Sakuma fails to remedy the deficiencies of Sasaki et al. '370 as described above with respect to the rejections under 35 U.S.C. §102(e). It is described in the present application that particles with the recited dimensions have a shape that "is not a so-called cigar shape or an acicular or tabular form, but a disk-like shape or an elliptical shape keeping a sphere to some extent, such as a rugby ball shape" (see page 12, line 24 to page 13, line 2). The present application also teaches that "such a shape can be generally regulated according to $0.5 < b/a < 1$ and $0.4 < c/b < 0.8$ (see page 13, lines 2-4). To the contrary, Sakuma teaches that "since each of the resin particles has a boundary line, the number of particles per unit weight is large in comparison with non-spherical resin particles having no boundary line, for example, hemispherical, rugby ball shaped, wooden-bowl shaped and go stone shaped particles which have been reported" (see paragraph [0117] in Sakuma). Sakuma thus requires particles with a distinct boundary line, and specifically indicates that the particles therein are shaped differently than the particles disclosed in the present application having a rugby ball shape. Sakuma specifically teaches away from rugby ball shape

particles, indicating that such particles lack a sufficient number of particles per unit weight, and thus teaches away from the recited dimensions in the present claims.

Contrary to the Patent Office's allegations, Applicant's arguments that Sakuma does not teach an elliptical or "rugby-shaped" particle are not moot because the arguments illustrate that Sakuma not only fails to teach or suggest particle dimensions that satisfy the recited equations, but also teaches away from particle dimensions that satisfy the recited equations as required in claims 1, 15, and 18-20

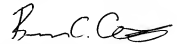
Therefore, Applicants assert the shape of the particles of Sakuma not only fail to teach or suggest particle dimensions that satisfy the recited equations, but in fact teach away from particle dimensions that satisfy $0.5 < b/a < 1$ and $0.4 < c/b < 0.8$ as required in claims 1, 15, and 18-20. Thus, the combination of Sasaki et al. '370 and Sakuma does not achieve the present resin powder having particles with dimensions that satisfy the equations specifically defined in claims 1, 15 and 18-20.

III. Conclusion

In view of the foregoing, Applicants maintain that all of the pending claims are patentable over the applied prior art, and requests withdrawal of the rejections and allowance of the application.

Should the review panel believe that anything further is desirable to place the application in even better condition for allowance, it is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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